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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,892	10/13/2000	Phillip Koh-Kwe Hsu	74622-014	8983
21890	7590	12/11/2006	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299				CHANDLER, SARA M
ART UNIT		PAPER NUMBER		
		3693		

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/687,892	HSU ET AL.
	Examiner	Art Unit
	Sara Chandler	3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 November 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 and 21-26 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 and 21-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 09/687,892 (10/13/00) filed on 11/03/06.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed, US Pat. No. 6,088,717 in view of Hanson, US Pat. No. 6,505,233.

Re Claims 1 and 25: Reed discloses a computer system for delivering financial messages to a client user, different from an internal user, the computer system comprising (Figs. 1,8; col. 100, lines 58-67; col. 134, line 30-col. 136, line 41; email, Fig. 8; 842, Fig. 17; col. 19, lines 26-40; col. 1, lines 50-53; email notification, col. 6, lines 63-67; receipt of financial transaction, cols. 119-123, especially col. 122, lines 35-67;

user (2, Fig. 1; e.g., sales/price data, Figs. 23-24; payment activity, col. 95, lines 58-65; car price data, col. 115, line 2- col. 116, line 62) (See Nonfunctional Descriptive Material Rationale)(See Intended Use Rationale):

at least one processor and at least one data storage device in communication with the at least one processor (abstract, col. 4, lines 49-52; col. 5, lines 49-51; col. 7, lines 47-51; col. 8, lines 54-57; col. 13, lines 14-16; col. 14, lines 10-15; col. 15, lines 16-18; col. Col. 16, lines 38-43; col. 18, lines 66+-col. 19, line 1; col. 20, lines 14-16; col. 27, lines 21-24; col. Col. 27, lines 47-58; col. 35, lines 13-18; col. 70, lines 25-42; col. 71, lines 12-22; col. 73, lines 40-52; col. 74, lines 25-30; col. 35, lines 35-47),

wherein the at least one data storage device stores a messaging system comprising a registration system program configured to register the client user and determine the client user's preferences for financial messages to be received by the client user (Figs. 23-24; contact information, col. 1, lines 45-50; logon, col. 4, lines 45-58; storing email addresses, col. 5, lines 5-11; establish an account, col. 4, lines 54-58) (See Nonfunctional Descriptive Material Rationale)(See Intended Use Rationale);

a message creation system program (Figs. 1, 8, 17; cols. 115-118, especially col. 117, lines 13-25) configured to monitor financial activity and an investment account of the client user, (e.g., sales/price data, Figs. 23-24; searching ads and then paging the potential buyer, col. 115, line 2-col. 118, line 35; col. 122, lines 35-67), create the financial messages as requested by the client user in accordance with the client user's preferences regarding the monitored financial activity and the client user's investment account, and deliver the financial messages to the client user (Figs. 23-24; or col. 2,

lines 2-5; customer preferences, col. 4, lines 45-58; col. 5, lines 5-66)(See Nonfunctional Descriptive Material Rationale)(See intended use rationale), and an intervention system program configured to allow the internal user to create, edit and maintain administrative, system name or address changes, data and instructions (e.g., col. 7, lines 54-59; provider program used to edit, col. 8, lines 65-67)(See Nonfunctional Descriptive Material Rationale)(See Intended Use Rationale).

Reed fails to explicitly disclose wherein the internal user of the system is allowed to at least one of add to and edit the financial messages to the client user prior to delivery. Hanson discloses wherein the internal user of the system is allowed to at least one of add to and edit the financial messages to the client user prior to delivery (abstract, col. 3, lines 33-39, col. 3, lines 45-49; col. 4, lines 19-27; col. 4, lines 66-col. 5, lines 1-3; Fig. 1; col. 6, lines 39-46, participants can update, add content, retrieve) (See Nonfunctional Descriptive Material Rationale)(See Intended Use Rationale).

Nonfunctional Descriptive Material: Reed and Handson disclose the claimed invention except for some nonfunctional descriptive material incorporated in the claims. It has been held that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, F. 3d, 2004 WL 1068957 (Fed. Cir. May 13, 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). (See also MPEP 2106.01)

Intended Use: Intended use does not carry patentable weight and does not differentiate over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the claim limitations are intended to be used in the delivery of financial messages related to financial activity and investment accounts of the client user however, the system of the prior art is capable of performing the intended use because of its capability in delivering messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reed with the teachings of Hanson to provide for adding to and editing the content of a message to a client user prior to delivery. One would have been motivated, as Hanson suggests, to reduce the amount of media needed , and make collaboration of information more rapid and interactive (col. 4, lines 43-48). Collaboration may involve reaching a decision, conducting a financial transaction or sharing knowledge (col. 5, lines 20-24).

Re Claim 2: Reed discloses wherein the registration system program includes a registration interface module configured to create a client user preference designation interface to determine the messages to be received by the client user (Figs. 23-24; or col. 2, lines 2-5; consumer editable, col. 20, lines 5-16; registering email addresses and stem lds, col. 24, lines 25-65; paging the potential buyer when preference met, col. 115, line 2-col. 116, line 62).

Re Claim 3: Reed discloses the message creation system program further comprising a program for providing a user message inbox for viewing a client user message (using

an email program, col. 27, lines 59-67; Fig. 8; col. 6, lines 1-27; storing emails, col. 5, lines 5-40; col. J90, lines 32-67).

Re Claim 4: Reed discloses wherein the system is accessible by the client user from an online financial transaction forum (e.g., col. 7, lines 2-12; cols. 119-123, especially col. 122, lines 35-67; broadcasting, col. 136, lines 27-41).

Re Claim 5: Reed discloses the message creation system program further comprising an internal user interface system program (col. 6, lines 1-27; col. 7, lines 54-59; col. 142, lines 30-col. 144, line 33).

Re Claim 6: Reed discloses wherein the internal interface system program (provider program, Figs. 1,5,7,21; col. 7, lines 54-59) comprises a financial advisor interface module configured to provide:

an advisor client user preference designation for designating client user preferences (Figs. 23-34);

an advisor preference interface for designating advisor message preferences (provider program, Figs. 1,5,7, or 21; col. 7, lines 54-59); and

an advisor message inbox for viewing client user or advisor messages (provider/email program, Figs. 1,5,7,21).

Re Claim 7: Reed discloses the message creation system program further comprising a program providing a client user searching mechanism (e.g., Fig. 14; col. 32, lines 50-62; querying, col. 38, lines 4-20; col. 62, lines 1-30; col. 90, lines 32-67; searching ads and then paging the potential buyer, col. 115, line 2-col. 116, lines 62).

Re Claim 8: Reed discloses the message creation system program further comprising a reporting system for generating reports (col. 15, lines 43-58; col. 29, lines 18-47; col. 31, lines 41-48; col. 90, lines 32-67; col. 93, line 40-col. 94, line 44).

Re Claim 9: Reed discloses the message creation system program further comprising a program for providing a user list edit interface which prevents delivery of a message to the client user (Figs. 23-34; filtering email, col. 27, lines 59-67; col. 28, lines 31-44; or col. 142, lines 30-col. 144, line 33).

Re Claim 10: Reed discloses the message creation system program further comprising a program for providing a manager user message viewing interface (provider program, Figs. 1,5,7,21; col. 90, lines 32-67).

Re Claim 11: Reed discloses the message creation system program further comprising a program for providing a client service agent interface including a message viewing interface (col. 6, lines 1-27; or Fig. 8; email programs, Figs. 1,5,7,21);.

Re Claim 12: Reed discloses the message creation system program further comprising a program for providing a marketing interface including a disclaimer interface (licensing rules, col. 95, lines 4-12), a message type creating interface and a message template editing interface (see, e.g., email program, Figs. 1,5,7,21; col. 44-61; col. 13, lines 46-50; col. 28, lines 1-16).

Re Claim 13: Reed discloses a market feed for supplying market data (the term market is not further defined, reads on at least clothing market, sales/price data, Figs. 23-24; inputting market data about e.g., prices of automobiles and then paging the potential buyer, col. 115, line 2-col. 118, line 35).

Re Claim 14: Reed discloses the message creation system program further comprising a security and authentication system program for controlling access to and within the system (e.g., col. 26, lines 18-41; Fig. 6A; col. 98, lines 9-47; col. 108, line 15-col. 113, line 64).

Re Claim 15: Reed discloses the message creation system program further comprising a program for providing at least one of an on-line chat system, a video conference system and a webcasting system (e.g., col. 7, lines 2-12; many-to-many, col. 2, lines 1-41).

Re Claim 16: Reed discloses wherein the financial messages are deliverable via electronic mail, facsimile, telephone, or wireless device (e.g., col. 44-61; col. 13, lines 46-50; col. 28, lines 1-16).

Re Claim 17: Reed discloses an internal user interface system for an internal user of a financial message delivery system, the interface system comprising:
means for designating message preferences of a client user for receiving client messages from an internal user, different from the client user, concerning financial activity and the client user's investment (searching ads and then paging the potential buyer, col. 115, line 2-col. 116, line 62) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale) ;
means for designating message preferences for sending internal user messages to the client user concerning financial activity and the client user's investment account (searching ads and then paging the potential buyer, col. 115, line 2-col. 116, line 62) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale);

means for the internal user to view the client user messages or the internal user message preferences for sending internal user messages to the client user concerning financial activity and the client user's investment account (Figs. 1, 8; col.. 100, lines 58-67) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale); means for monitoring financial activity and the client user's investment account in accordance with the client user's message preference (Figs. 1, 8, 17; cols. 115-118, especially col. 117, lines 13-25; e.g., sales/price data, Figs. 23-24; searching ads and then paging the potential buyer, col. 115, line 2-col. 118, line 35; col. 122, lines 35-67; Figs. 23-24; or col. 2, lines 2-5; customer preferences, col. 4, lines 45-58; col. 5, lines 5-66) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale); means for automatically generating messages to be sent to the client user concerning the financial activity and the client user's account in accordance with the designated client user preferences (email program, Figs. 1,5,7,21) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale); and means for the client user to search messages sent to or received from the client user (e.g., Fig. 14; col. 32, lines 50-62; querying, col. 38, lines 4-20; col. 62, lines 1-30; col. 90, lines 32-67; searching ads and then paging the potential buyer, col. 115, line 2-col. 116, line 62) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale).

Reed fails to explicitly disclose: wherein the message preferences are internal user message preferences; and means for the internal user to add to or edit content of the automatically generated messages. Hanson discloses wherein the message

preferences are internal user message preferences (col. 6, lines 56-64); and means for the internal user to add to or edit content of the automatically generated messages (abstract, col. 3, lines 33-39, col. 3, lines 45-49; col. 4, lines 19-27; col. 4, lines 66-col. 5, lines 1-3; Fig. 1; col. 6, lines 39-46, participants can update, add content, retrieve) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale).

Nonfunctional Descriptive Material: Reed and Hanson disclose the claimed invention except for some of the information as claimed. It has been held that nonfunctional descriptive material cannot render nonobvious an invention that would otherwise been obvious. *In re Ngai*, F. 3d, 2004 WL 1068957 (Fed. Cir. May 13, 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). (See also MPEP 2106.01)

Intended Use: Intended use does not carry patentable weight and does not differentiate over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the claim limitations are intended to be used in the delivery of financial messages related to financial activity and investment accounts of the client user however, the system of the prior art is capable of performing the intended use because of it's capability in delivering messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reed with the teachings of Hanson to provide a means for

designating internal user message preferences. One would have been motivated, as suggested by Hanson, to provide users with a means to limit participation by unwanted users, restrict the number of users receiving messages (col. 2, lines 2-14).

Re Claims 18,22-24 and 26: Reed discloses a computerized method for delivering one or more financial messages to a client user from an internal user, different from the client user, related to an investment account of the client user in a financial communication system, comprising the steps of:

obtaining client user message preferences concerning the topics of the financial messages (Figs. 23-24; or paging the potential buyer when criteria met, col. 115, line 2- col. 116, line 62) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale);

storing the client user message preferences (abstract, col. 4, lines 49-52; col. 5, lines 49-51; col. 7, lines 47-51; col. 8, lines 54-57; col. 13, lines 14-16; col. 14, lines 10-15; col. 15, lines 16-18; col. Col. 16, lines 38-43; col. 18, lines 66+-col. 19, line 1; col. 20, lines 14-16; col. 27, lines 21-24; col. Col. 27, lines 47-58; col. 35, lines 13-18; col. 70, lines 25-42; col. 71, lines 12-22; col. 73, lines 40-52; col. 74, lines 25-30; col. 35, lines 35-47) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale);

monitoring financial activity and the investment account of the client user in accordance with the client user message preferences (Figs. 1, 8, 17; cols. 115-118, especially col. 117, lines 13-25; e.g., sales/price data, Figs. 23-24; searching ads and then paging the

potential buyer, col. 115, line 2-col. 118, line 35; col. 122, lines 35-67; Figs. 23-24; or col. 2, lines 2-5; customer preferences, col. 4, lines 45-58; col. 5, lines 5-66); and automatically creating the financial messages regarding the monitored financial activity and the client user's investment account in accordance with the client user message preferences (Figs. 23-24; col. 116, lines 52-62; col. 44-61; col. 13, lines 46-50; col. 28, lines 1-16) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale); and

the financial communication system delivering the financial messages to the client user in accordance with the client user message preferences (email program, Figs. 1,5,7,21) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale).

Reed fails to explicitly disclose enabling the internal user to add to or edit the content of the financial messages. Hanson discloses enabling the internal user to add to or edit the content of the financial messages ((abstract, col. 3, lines 45-49; col. 4, lines 19-27; col. 4, lines 66-col. 5, lines 1-3; Fig. 1; col. 6, lines 39-46, participants can update, add content, retrieve) (See Nonfunctional Descriptive Material Rationale) (See Intended Use Rationale).

Nonfunctional Descriptive Material: Reed and Hanson disclose the claimed invention except for some of the information as claimed. It has been held that nonfunctional descriptive material cannot render nonobvious an invention that would otherwise been obvious. *In re Ngai*, F. 3d, 2004 WL 1068957 (Fed. Cir. May 13, 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). (See also MPEP 2106.01)

Intended Use: Intended use does not carry patentable weight and does not differentiate over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the claim limitations are intended to be used in the delivery of financial messages related to financial activity and investment accounts of the client user however, the system of the prior art is capable of performing the intended use because of it's capability in delivering messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Read with the teachings of Hanson to allow an internal user to add a personalized note to the client user prior to delivery. One would have been motivated, as Hanson suggests, to reduce the amount of media needed , and make collaboration of information more rapid and interactive (col. 4, lines 43-48). Collaboration may involve reaching a decision, conducting a financial transaction or sharing knowledge (col. 5, lines 20-24).

Re Claim 19: Reed discloses wherein the step of gathering client user message preferences comprises providing a user interface for an internal user designation of the client user message preferences (Figs. 23-24; or col. 2, lines 2-5; consumer editable, col. 20, lines 5-16; registered email addresses and system lds, col. 24, lines 25-65; paging the potential buyer when preference met, col. 115, line 2-col. 116, line 6).

Re Claim 20: (Cancelled).

Re Claim 21: Reed discloses a method further comprising the step of reviewing messages prior to delivery for regulatory compliance (licensing rules, col. 95, lines 4-12; paging the potential buyer when preferences met, compliance of ad provider, col. 115, line 2-col. 116, line 6; sales/price data, Figs. 23-24).

Response to Arguments

Applicant's arguments with respect to claims 1-19 and 21-26 have been considered but are moot in view of the new ground(s) of rejection.

The Office Action (05/04/06) explains why the prior art (i.e., Reed, Hanson) is capable of performing the claimed invention. Applicant's remarks and amendments to the claims comprise arguments regarding nonfunctional descriptive material incorporated into the claim language and the intended use of the claimed invention. Thus, the amended claims are further rejected under this rationale. See above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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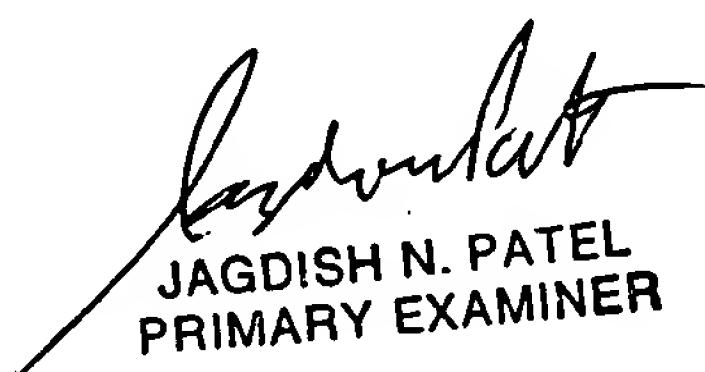
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



JAGDISH N. PATEL
PRIMARY EXAMINER